

REMARKS

Applicant proposes amendments to independent claims 1, 9, 17, 21, 24, 27, 31, 33, and 34. Claims 1, 4, 5, 8, 9, 12, 14-21, 23, 24, and 26-34 remain pending in this application.

In the Final Office Action,¹ the Examiner took the following actions:

rejected claims 1, 4, 5, 9, 12, 14, 15, 17, 18, 21, 24, 27, 28, 31, 33, and 34 under 35 U.S.C. § 103(a)² as being unpatentable over Bull et al. (U.S. Patent No. 5,995,943) in view of Rodkin et al. (U.S. Patent No. 6,092,074); and

rejected claims 8, 16, 19, 20, 23, 26, 29, 30, and 32 under 35 U.S.C. § 103(a) as being unpatentable over Bull in view of Rodkin and in further view of Kirsch et al. (U.S. Patent No. 6,189,030).

I. Request for Acknowledgement of Information Disclosure Statement

As an initial matter, Applicant notes that an Information Disclosure Statement (IDS) was filed on June 5, 2008. To date, Applicant has not received an initialed copy of the IDS Form PTO/SB/08, which accompanied the IDS. Accordingly, Applicant respectfully requests that the Examiner consider the cited documents and return a copy of the IDS Form with an appropriate acknowledgment of the Examiner's consideration.

¹ The Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Final Office Action.

² Although the caption of the rejection states that the ground of rejection is under 35 U.S.C. § 102(e), based on the substance of the rejection, Applicant believes the rejection was intended under 35 U.S.C. § 103(a).

II. Rejections of Claims under § 103(a)

Applicant respectfully traverses the rejection of claims 1, 4, 5, 9, 12, 14, 15, 17, 18, 21, 24, 27, 28, 31, 33, and 34 under 35 U.S.C. § 103(a) as being unpatentable over Bull in view of Rodkin et al. A *prima facie* case of obviousness has not been established.

“The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements. M.P.E.P. § 2142, 8th Ed., Rev. 7 (July 2008)(internal citation and inner quotation omitted). “[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). In rejecting a claim, “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Independent claim 1, as proposed to be amended, recites an apparatus for hyperlinking specific words in content to convert the words into advertisements including, among other things, “code” in a content file that:

(1) “references said ad server to determine at least one existing advertiser-chosen word present in said content file”

and

(2) “said code automatically, as said content file is interpreted by said web browser, providing a hypertext anchor for said at least one existing advertiser-chosen word, thereby converting said at least one existing advertiser-

chosen word into an advertisement by linking said at least one advertiser-chosen word to said advertiser web page” (emphasis added).

The cited references do not teach or suggest at least these elements of independent claim 1.

Bull discloses that pre-prepared ads are inserted into a web page. For example, Fig. 6 of Bull shows an arrow labeled “GET AD TO INSERT,” indicating that an ad is retrieved from advertising database 250. After retrieving the ad, the Bull system will then “cause an advertisement/coupon to be added into the display.” See col. 12, lines 15-16. While Bull teaches that page content in the form of an ad is added, Bull does not teach or suggest Applicant’s claimed “code” in a content file that “references said ad server to determine at least one existing advertiser-chosen word present in said content file” and “as said content file is interpreted by said web browser, provid[es] a hypertext anchor for said at least one existing advertiser-chosen word, thereby converting said at least one existing advertiser-chosen word into an advertisement by linking said at least one advertiser-chosen word to said advertiser web page,” as recited in independent claim 1 (emphasis added).

The Final Office Action alleges that “no patentable weight” was given to the claim language of “said code automatically, when said content file is interpreted by a web browser, providing a hypertext anchor for said at least one existing advertiser-chosen word, thereby converting said at least one existing advertiser-chosen word into an advertisement by linking said at least one advertiser-chosen word to said advertiser web page,” because the language does not limit the claim to a particular structure. See Final Office Action at page 3. Although Applicant disagrees, Applicant has proposed amendments to claim 1 to clarify that the claim language is not optional.

The Final Office Action further contends that Rodkin teaches the alleged “optional limitation” at col. 15, lines 8-17 and 36-42. Final Office action at page 3. However, this is incorrect.

Rodkin discloses:

The character strings from the annotation database, i.e., the strings which are searched, can therefore be used by annotator software of the Intelligent Annotator™ 520 to automatically build a DFA whose terminal states indicate that a matching character string from the annotation database 535 has been found in the article to be annotated 405. Once a matching character string is found, the Intelligent Annotator™ 520 provides an anchor code which references a destination address in the destination and expiration database 540.

...

The Intelligent Annotator™ traverses the text of the article. That is, each word or phrase is examined to determine whether the text should be converted to hypertext. Moreover, for words or phrases which already have conventional hypertext anchors, the new anchor data in accordance with the present invention can either overwrite the old anchor data, or be inserted along with the old anchor data. Therefore, the article to be annotated 405 may be a text file with no hyperlinks, or a file with conventional hyperlinks. Additionally, as mentioned, the article to be annotated need not be a discrete file, but may comprise computer information from any source, and in any format.

Col. 15, lines 8-17 and 36-47.

As set forth above, the Intelligent Annotator 520 of Rodkin determines whether to convert text to hypertext. Specifically, as shown in, for example, Figure 5 of Rodkin, the Intelligent Annotator 520 is a component of content server 410. Accordingly, Rodkin discloses a content server that uses the Intelligent Annotator to convert text to hypertext at the content server. However, the Intelligent Annotator in Rodkin does not constitute or suggest Applicant’s claimed “code.” Rather, the Intelligent Annotator in Rodkin

converts text to hypertext at content server 410, but Rodkin does not teach or suggest Applicant's claimed "code" in a content file that (1) "references said ad server to determine at least one existing advertiser-chosen word present in said content file" and (2) "as said content file is interpreted by said web browser, provid[es] a hypertext anchor for said at least one existing advertiser-chosen word, thereby converting said at least one existing advertiser-chosen word into an advertisement by linking said at least one advertiser-chosen word to said advertiser web page," as recited in independent claim 1 (emphasis added).

As explained above, the elements of independent claim 1 are neither taught nor suggested by the cited references. Moreover, there is no teaching in the cited references that would motivate one of ordinary skill in the art to modify the disclosures thereof to achieve the claimed combination. Consequently, the Final Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and independent claim 1. Accordingly, no reason has been clearly articulated as to why independent claim 1 would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for independent claim 1 and the Examiner should withdraw the rejection of the claim under 35 U.S.C. § 103(a).

Independent claims 9, 17, 21, 24, 27, 31, 33, and 34, although of a different scope from independent claim 1 and each other, include recitations similar to those discussed above in connection with independent claim 1. Accordingly, a *prima facie* case of obviousness has not been established for independent claims 9, 17, 21, 24, 27, 31, 33, and 34 for at least the reasons discussed above. Furthermore, claims 4, 5, 12,

14, 15, 18, and 28 are allowable at least due to their dependence from the independent claims. Therefore, the Examiner should also withdraw the rejection of claims 1, 4, 5, 9, 12, 14, 15, 17, 18, 21, 24, 27, 28, 31, 33, and 34 under 35 U.S.C. § 103(a).

Independent claim 31, as proposed to be amended, further recites “positioning a mouse pointer over the hyperlink, the positioning causing a description of the advertiser web page to be displayed.” The Final Office Action admits that “Bull et al. does not explicitly teach (independent claim 31) displaying a description of the advertiser web page when a mouse pointer is positioned over the hyperlink” (emphases in original). See page 4. The Examiner then alleges that principles of inherency make up for this admitted deficiency of Bull. Applicant disagrees.

MPEP § 2112.02 explains that, “[u]nder the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device. When the prior art device is the same as a device described in the specification for carrying out the claimed method, it can be assumed the device will inherently perform the claimed process.” See MPEP § 2112.02, citing *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986). The Final Office Action cites a portion of Bull that “teaches clicking on a URL … to access a Web page.” See page 4. Regarding this teaching, the Office Action further alleges that “[t]he mouse pointer must inherently be positioned over the URL link in order to activate said link by clicking on it.” However, positioning a mouse pointer over a URL link in order to click on the link does not constitute “positioning a mouse pointer over the hyperlink, the positioning causing a

description of the advertiser web page to be displayed,” as recited in claim 31 (emphasis added).

Moreover, the principles of inherency do not apply in the present instance, because nothing in Bull indicates that it would “necessarily perform the method claimed,” as required by MPEP § 2112.02. Instead, Bull only discloses clicking a URL, but does not teach “positioning a mouse pointer over the hyperlink, the positioning causing a description of the advertiser web page to be displayed,” as recited in claim 31 (emphasis added).

The Final Office Action further alleges that “said web page itself reading on a ‘description of the advertiser web page.’” Final Office Action at page 5. This is incorrect for at least two reasons. First, Applicant’s claim 31 recites displaying a “description,” not displaying the web page itself. Second, the Final Office Action ignores that it is the “positioning [of] a mouse pointer over the hyperlink” that causes the description to be displayed, not clicking on a link. Moreover, Rodkin does not compensate for these deficiencies of Bull. Accordingly, the rejection of independent claim 31 is improper for at least these additional reasons.

Applicant respectfully traverses the rejection of claims 8, 16, 19, 20, 23, 26, 29, 30, and 32 under 35 U.S.C. § 103(a) as being unpatentable over Bull in view of Rodkin and in further view of Kirsch. A *prima facie* case of obviousness has not been established.

As discussed above, Bull and Rodkin do not teach or suggest all of the elements of independent claims 1, 9, 17, 21, 24, 27, and 31, from which claims 8, 16, 19, 20, 23, 26, 29, 30, and 32 depend. Furthermore, Kirsch does not compensate for the

deficiencies of Bull and Rodkin and, accordingly, the elements of the claims are neither taught nor suggested by the cited references at least due to their dependence.

Consequently, the Final Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claims. Accordingly, no reason has been clearly articulated as to why the claims would have been obvious to one of ordinary skill in view of the prior art.

Therefore, a *prima facie* case of obviousness has not been established for claims 8, 16, 19, 20, 23, 26, 29, 30, and 32 and the Examiner should withdraw the rejection of the claims under 35 U.S.C. § 103(a).

CONCLUSION

Applicant respectfully requests that the Examiner enter this Amendment under 37 C.F.R. § 1.116, placing the pending claims in condition for allowance. Applicant submits that the proposed amendments do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicant respectfully points out that the final action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of the Amendment would allow the Applicant to reply to the final rejections and place the application in condition for allowance.

Finally, Applicant submits that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

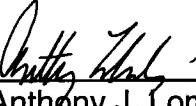
In view of the foregoing remarks, Applicant submits that the claims, as amended, are neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: February 2, 2009

By: 
Anthony J. Lombardi
Reg. No. 53,232